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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,460	02/28/2002	Steven W. Trovinger	10014012	4991

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
3722	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/084,460

Applicant(s)

TROVINGER, STEVEN W.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-26 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-20 is/are rejected.
- 7) ☒ Claim(s) 4,5 and 27-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 5, and 14 have been amended for further examination. Claims 23-34 have been added. The drawings have been amended to overcome the previous objections.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3, and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/084,459 in view of Weber (4,735,406).

Trovinger ('459) discloses a booklet maker system comprising: a collecting device including two supporting sides formed with a saddle shape; and a transferring device (clamping device) including a displaceable clamping component; wherein the transferring device displaces along a non-linear path (or rotates) to deliver the folded sheet to the collecting device.

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However, Trovinger does not disclose: a pivotable collecting device; and a reciprocating (Webster's Dictionary defines as "to move forward and backward alternately") transferring device.

Weber discloses in Fig. 3, a booklet maker comprising a pivotable collecting device (3, wherein the collecting device pivots around shaft (1)); and a reciprocating transferring device (28) which delivers a folded sheet to the collecting device (Col. 7, lines 50-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Trovinger's booklet maker system with a pivotable collecting device and a reciprocating transferring device as taught by Weber for the purpose of providing an alternative means in which a signature can be collected before being bound.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-3, 6, 14, 15, 18-20 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Weber (4,735,406).

Weber discloses in Fig. 1, 3 and 4, a booklet maker and a method of making booklets comprising: a pivotable collecting device (3); a reciprocating transferring device (28) including a displaceable clamping component (32) which clamps the folded sheet (Col. 7, lines 50-53), wherein the transferring device reciprocates along a non-linear path (arc path due to cam rotating) to deliver and secure a folded sheet to the collecting device; wherein the collecting device pivots (around hub (2)) to receive the folded sheet material such that portions are supported by different opposite sides of the collecting device (3); wherein the collecting device (3) converges at a supporting edge (seen in Fig. 3); transferring additional folded sheets to the collecting device wherein an inner fold edge of each sheet is received by an outer fold edge of a previously received sheet (Col 8, lines 4-24); stapling the stack of folded sheet material (Col. 8, line 24).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Allan et al (6,099,225) in view of Weber.

Allan et al discloses in Fig. 1, 2 and 4, a booklet maker and a method of making booklets comprising a collecting device (460) including two supporting sides, a transferring device (400), a folding device (430) for establishing a fold (240A) in a trimmed sheet material (wherein Fig. 2 discloses that the sheet is trimmed (220) by cutting (450) before it is folded); an input feed device (210) connected to an output tray (not shown) of a printing device (110); and a processing unit (Col. 4, lines 20-67).

However, Allan et al does not disclose a pivotable collecting device and a reciprocating transferring device.

Weber discloses in Fig. 1, 3 and 4, a booklet maker and a method of making booklets comprising: a pivotable collecting device (3); a reciprocating transferring device (28) including a displaceable clamping component (32) which clamps the folded sheet (Col. 7, lines 50-53), wherein the transferring device reciprocates along a non-linear path (arc path due to cam rotating) to deliver and secure a folded sheet to the collecting device; wherein the collecting device pivots (around hub (2)) to receive the folded sheet material such that portions are supported by different opposite sides of the collecting device (3); wherein the collecting device (3) converges at a supporting edge (seen in Fig. 3); transferring additional folded sheets to the collecting device

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wherein an inner fold edge of each sheet is received by an outer fold edge of a previously received sheet (Col 8, lines 4-24); stapling the stack of folded sheet material (Col. 8, line 24) which forms a hole.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allan et al's booklet maker and method of making booklets with a reciprocating transferring device and a pivotable collecting device as taught by Weber for the purpose of providing an alternative means in which to convey a sheet material from the folding device to a collecting device.

***Allowable Subject Matter***

6. Claims 21-26 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a system for making booklets comprising a folding device; a saddle shaped pivotable collecting device; a rotatable transferring device; and a collecting drive for clamping a portion of the folded sheet material against the collecting device and for advancing the portion along a side of the collecting device; and including all of the other limitations of the independent claim.



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8. Claims 4, 5, and 27-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection. The Weber reference has now been used to disclose booklet maker having a reciprocating transferring device which reciprocates along a non-linear path.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

July 10, 2004



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